

REMARKS

Following entry of the above amendment, claims 29, 47, and 49-61 will be pending in this application, claims 28, 30, 41-46, and 48 having been canceled and new claims 49-61 added. Support for the new claims can be found, e.g., at page 15, lines 12-19. No new matter has been added.

Rejection under 35 USC § 112, first paragraph

Claims 28, 30, and 41-46 were rejected under § 112, first paragraph, as allegedly not enabled for 1) an antibody that specifically binds to a polypeptide having an amino acid sequence at least 90, 95, or 99% identical to SEQ ID NO:2, or 2) an antibody that specifically binds to a polypeptide encoded by a first nucleic acid that hybridizes under stringent conditions to a second nucleic acid consisting of SEQ ID NO:3, or 3) an antibody that specifically binds to a polypeptide the amino acid sequence of which consists of SEQ ID NO:2 with up to 30, 15, 5, or 3 amino acid substitutions. Applicants strongly disagree with the rejection for at least the arguments previously presented. However, claims 28, 30, 41-46, and 48 have been canceled for reasons orthogonal to the rejection for alleged lack of enablement.

At page 3, paragraph 2, of the Office action, the Examiner made statements that could be interpreted as disparaging of U.S. Patent 6,784,284, the parent of the instant application. As is every patent, the '284 patent is presumed to be valid. 35 U.S.C. § 282, first sentence. MPEP 1701 clearly bars patent examiners from expressing "any opinion as to the validity or invalidity of, or the patentability or unpatentability of any claim in any U.S. patent," except in specific proceedings regarding the patent. Furthermore, Applicants maintain that the claims of the '284 patent are valid, and comply fully with the written description and enablement requirements of 35 U.S.C. § 112. The positions taken by the Examiner regarding the '284 patent are clearly not in accord with the position of the U.S. Patent and Trademark Office as expressed in the MPEP, the Written Description Guidelines, the Enablement Guidelines, and hundreds of gene and polypeptide patents issued in the last several years. Applicants request that the Examiner withdraw his statements and affirm his recognition that, under U.S. law, the '284 patent is presumed valid.

Applicant : Naoki Kimura et al.
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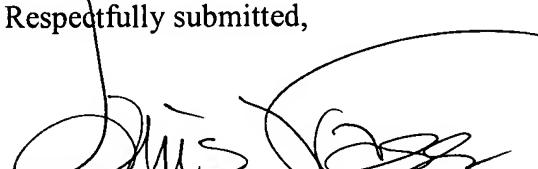
Rejection under 35 USC § 112, first paragraph

Claim 47 was rejected as allegedly drawn to new matter. Applicants disagree, as there is clear support in the specification for the claimed antibody. Support for antibodies that bind to polypeptides of the invention can be found in the specification, e.g., at page 14, line 12 to page 15, line 11. Support for "the extracellular region of 7F4 (SEQ ID NO:14)" (i.e., a polypeptide of the invention) can be found in the specification, e.g., at page 28, lines 4-23 and Fig. 2. Furthermore, Example 5 describes the preparation of antisera against the extracellular region of 7F4. These antisera were shown to bind specifically to the surfaces of cells expressing 7F4 (Example 6). Therefore, one of skill in the art would understand that applicants had possession of the invention of claim 47 at the time of filing, and it does not constitute new matter. Applicants request reconsideration and withdrawal of the rejection for alleged new matter. Furthermore, applicants request withdrawal of the premature finality of the rejection (MPEP 706.07(d)).

Applicants respectfully submit that the present claims are in condition for allowance and request confirmation of such from the Examiner. No fee is believed required. Please apply any charges or credits to deposit account 06-1050, referencing Attorney Docket No. 14875-040003.

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Respectfully submitted,


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